

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

BFS BRANDS, LLC,

and

BRIDGESTONE/FIRESTONE NORTH  
AMERICAN TIRE, L.L.C.,

Opposers,

v.

ORTECK INTERNATIONAL, INC.,

Applicant.

Opposition No. 154,661  
Serial No. 76/369,339

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RESPONSE TO NOTICE MAILED FEBRUARY 11, 2005

Sir:

On December 10, 2004, Applicant filed an express abandonment of the above-referenced application. The Board noted that the "letter agreement" referenced was not included with the express abandonment. The Board also noted that a written consent from Opposer was not included. Enclosed herewith is a copy of the subject letter agreement signed by Opposer. .

Respectfully submitted,

March 14, 2005  
Date


Deborah J. Westervelt  
Deborah J. Westervelt  
Royal W. Craig  
The Law Offices of Royal W. Craig  
10 North Calvert Street, Suite 153  
Baltimore, Maryland 21202  
Attorneys for Orteck International, Inc.

**CERTIFICATE OF SERVICE**

I hereby certify that on this 14th day of March 2005, copies of the foregoing were sent  
via Express mail to:  
The Assistant Commissioner  
For Trademarks  
Box TTAB No Fee  
2900 Crystal Drive  
Arlington, VA 2202-3513

and deposited in the U.S. mail, postage prepaid, to the following addressee:

Peter G. Mack, Esq.  
Geoffrey M. McNutt, Esq.  
Foley & Lardner  
Washington Harbour  
3000 K Street, N.W., Suite 500  
Washington, D.C. 20007

  
Deborah J. Westervelt  
The Law Offices of Royal W. Craig  
10 North Calvert Street, Suite 153  
Baltimore, Maryland 21202  
Attorneys for Orteck International, Inc.



# ORTECK INTERNATIONAL

7917 G&H CESSNA AVE., GAITHERSBURG, MD 20879. TEL: 240-683-4640, FAX: 240-683-4644

December 10, 2004

John M. Vasuta  
Bridgestone/Firestone North American Tire, LLC  
1200 Firestone Parkway  
Akron, Ohio 44317-0001

Re: BFS Brands, LLC and Bridgestone/Firestone North American Tire, LLC v.  
Orteck International Inc.  
Opposition No. 91154661 in the U.S. Patent and Trademark Office  
MILESTONE and MILESTONE ROAMER

Dear Mr. Vasuta:

I write to confirm that Orteck International, Inc., on behalf of itself, its officers, its directors and its principals, agrees to your terms for settlement of this opposition proceeding as well as settlement of the overall dispute concerning Orteck's use of the trademarks MILESTONE and MILESTONE ROAMER for tires. This letter agreement reflects the settlement terms.

In essence, Orteck agrees to terminate all use of the "Accused Trademarks," which are defined as the trademark or designation MILESTONE, the trademark or designation MILESTONE ROAMER, as well as any other trademark or designation ending with STONE, all in the context of tires, but not including any potential usage of FIRESTONE or BRIDGESTONE to identify genuine FIRESTONE or BRIDGESTONE tires manufactured and marketed by your company or its affiliates. The timeframe for the discontinuance is set forth below.

1. As of the date of this letter and thereafter, Orteck will refrain from engaging in the following activities and will also refrain from assisting others or acting in concert with others to engage in the following activities:

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- a. Soliciting or taking new orders for tires bearing the Accused Trademarks, except that Orteck will sell any inventory already produced as of the date of this letter agreement;
  - b. Using or distributing any printed materials, catalogs or promotional pieces featuring the Accused Trademarks;
  - c. Acquiring any new inventory of tires bearing the Accused Trademarks, except that Orteck will sell any inventory already produced as of the date of this letter agreement ; or
  - d. Manufacturing or having manufactured by others any tires bearing the Accused Trademarks.
2. Within four months from the date of this letter Orteck will:
- a. Eliminate from all websites it maintains, sponsors or otherwise uses, including, without limitation, the website accessed by the domain name <www.orteck.com>, all uses of MILESTONE, of MILESTONE ROAMER, and of any other marks that also fall within the definition of Accused Trademarks;
  - b. Destroy all catalog components and items and promotional literature that refer to or contain any reference to the Accused Trademarks; and
  - c. Terminate all sales and sales activities involving the Accused Trademarks, except that Orteck will sell any inventory already produced as of the date of this letter agreement.
3. Within six months of the date of this letter, Orteck will terminate every use of every kind whatsoever of the Accused Trademarks, will have disposed of all inventory of tires or any other items bearing the Accused Trademarks, will refrain from any adoption or future use of any of the Accused Trademarks, and will refrain from assisting others or acting in concert with others to engage in any uses of the Accused Trademarks. In this regard, the exceptions set forth in paragraphs 1 and 2 for inventory already produced as of the date of this letter do not apply to this paragraph 3 prohibiting all sales of tires under the Accused Trademarks beyond six months from the date of this letter and prohibiting all uses of the Accused Trademarks beyond that six month period of time.
4. By no later than the close of business on Friday, December 10, 2004, Orteck will cause to be filed with the U.S. Patent and Trademark Office an express abandonment with prejudice of its trademark application that is the subject of the opposition proceeding, namely, application Serial No. 76/369,339, filed February 8, 2002, to register the expression MILESTONE ROAMER. Such express abandonment shall be in a form acceptable to counsel who represents the opposers in connection with the opposition proceeding. We shall transmit a copy of the executed express abandonment form being filed with the U.S. Patent and Trademark Office to your counsel by no later than close of business on December 10, 2004.

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5. Contingent upon Orteck fulfilling all of its obligations as set forth above, your companies, the opposers, release Orteck from all claims and causes of action for trademark infringement, trade name infringement, unfair competition and the like arising out of Orteck's use of MILESTONE and MILESTONE ROAMER as trademarks or designations for tires. For its part, Orteck releases the opposers from any claims or causes of action relating to the opposers' filing or prosecution of the opposition proceeding and/or relating to opposers' demands that Orteck cease and desist from use of the Accused Trademarks.

6. The signatures below indicate the parties' acceptance and agreement to these terms.

ORTECK INTERNATIONAL, INC.

By: \_\_\_\_\_  
Title: \_\_\_\_\_

Agreed:

BFS BRANDS, LLC

John M. Vasuta  
John M. Vasuta  
General Counsel and Secretary

BRIDGESTONE/FIRESTONE NORTH  
AMERICAN TIRE, LLC

John M. Vasuta  
John M. Vasuta  
Assistant Secretary

## FACSIMILE COVER PAGE

Date: April 5, 2005

To: Cheryl Goodman - TTAB

Total Pages (including cover page): 6

Fax #: 571-273-4270

From: Debbie Westervelt

Law Offices of Royal W. Craig  
10 North Calvert Street, Suite 153  
Baltimore, Maryland 21202

Voice #: 410-385-2383

Fax #: 410-385-2385

### MESSAGE:

As you requested.  
Please see attached.

CONFIRMATION COPY WILL FOLLOW: YES ( ) NO ( )

CONFIDENTIALITY NOTICE: Unauthorized interception and use of this telephonic communication could be a violation of Federal and State Law. The documents accompanying this telecopy transmission contain confidential information belonging to the sender which is legally privileged. The information is intended only for the use of the individual or entity named above. If you are not the intended recipient, you are hereby notified that any disclosure, copying, distribution or the taking of any action in reliance on the contents of this telecopied information is strictly prohibited. If you have received this telecopy in error, please immediately notify us by telephone to arrange for return of the original document to us.

IF YOU HAVE ANY PROBLEM RECEIVING THIS FAX, CALL MURIEL CHIDER AT (410) 385-2383.